

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DISH NETWORK, LLC,
Petitioner,

v.

TQ DELTA, LLC,
Patent Owner.

Case IPR2017-00255
Patent 8,718,158 B2

Before SALLY C. MEDLEY, KALYAN K. DESHPANDE, and
TREVOR M. JEFFERSON, *Administrative Patent Judges*.

MEDLEY, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review
37 C.F.R. § 42.108
Petitioner's Motion for Joinder
37 C.F.R. § 42.122(b)

I. INTRODUCTION

DISH Network, L.L.C. (“Petitioner” or “Dish”) filed a Petition for *inter partes* review of claims 1–30 of U.S. Patent No. 8,718,158 B2 (Ex. 1001, “the ’158 patent”). Paper 3 (“Pet.”). Concurrently with its Petition, Dish filed a Motion for Joinder with *Cisco Systems, Inc. v. TQ Delta, LLC*, Case IPR2016-01021 (“the Cisco IPR”). Paper 2 (“Mot.”). TQ Delta, LLC (“Patent Owner”) submits that it does not oppose joinder. *See* Paper 8. Patent Owner also elected to waive its Preliminary Response. *Id.*

For the reasons explained below, we institute an *inter partes* review of claims 1–30 of the ’158 patent and grant Dish’s Motion for Joinder.

II. RELATED PROCEEDINGS

Petitioner and Patent Owner identify several pending judicial matters as relating to the ’158 patent. Pet. 1; Mot. 2–3; Paper 4, 2–3.

In the Cisco IPR, we instituted an *inter partes* review of claims 1–30 of the ’158 patent on the following ground:

References	Basis	Claims
Shively ¹ and Stopler ²	§ 103(a)	1, 2, 4, 15, 16, and 18
Shively, Stopler, and Gerszberg ³	§ 103(a)	3, 5, 14, 17, 19, and 28–30
Shively, Stopler, and Bremer ⁴	§ 103(a)	6, 9, 10, 12, 20, 23, 24, and 26

¹ U.S. Patent No. 6,144,696; issued Nov. 7, 2000 (Ex. 1011) (“Shively”).

² U.S. Patent No. 6,625,219 B1; issued Sept. 23, 2003 (Ex. 1012) (“Stopler”).

³ U.S. Patent No. 6,424,646 B1; issued July 23, 2002 (Ex. 1013) (“Gerszberg”).

⁴ U.S. Patent No. 4,924,516; issued May 8, 1990 (Ex. 1017) (“Bremer”).

References	Basis	Claims
Shively, Stopler, Bremer, and Gerszberg	§ 103(a)	8, 11, 13, 22, 25, and 27
Shively, Stopler, Bremer, and Flammer ⁵	§ 103(a)	7 and 21

Cisco Systems, Inc. v. TQ Delta, LLC, Case IPR2016-01021, slip op. at 20–21 (PTAB Nov. 4, 2016) (Paper 7) (“Cisco Dec.”).

III. INSTITUTION OF *INTER PARTES* REVIEW

The Petition in this proceeding asserts the same grounds of unpatentability as the ones on which we instituted review in the Cisco IPR. *Compare* Pet. 12–63, *with* Cisco Dec. 20–21. Indeed, Petitioner contends that the Petition asserts only the grounds that the Board instituted in the Cisco IPR, there are no new arguments for the Board to consider, and Petitioner relies on the same exhibits and expert declaration as the Cisco IPR. Mot. 5.

For the same reasons set forth in our institution decision in the Cisco IPR, we determine that the information presented in Dish’s Petition shows a reasonable likelihood that Petitioner would prevail in showing that (a) claims 1, 2, 4, 15, 16, and 18 would have been obvious over Shively and Stopler, (b) claims 3, 5, 14, 17, 19, and 28–30 would have been obvious over Shively, Stopler, and Gerszberg, (c) claims 6, 9, 10, 12, 20, 23, 24, and 26 would have been obvious over Shively, Stopler, and Bremer, (d) claims 8, 11, 13, 22, 25, and 27 would have been obvious over Shively, Stopler, Bremer, and Gerszberg, and (e) claims 7 and 21 would have been obvious over Shively, Stopler, Bremer, and Flammer. *See* Cisco Dec. 7–20.

⁵ U.S. Patent No. 5,515,369; issued May 7, 1996 (Ex. 1019) (“Flammer”).

Accordingly, we institute an *inter partes* review on the same grounds as the ones on which we instituted review in the Cisco IPR. We do not institute *inter partes* review on any other grounds.

IV. GRANT OF MOTION FOR JOINDER

The Petition and Motion for Joinder in this proceeding were accorded a filing date of November 11, 2016. *See* Paper 7. Thus, Petitioner's Motion for Joinder is timely because joinder was requested no later than one month after the institution date of the Cisco IPR, i.e., November 4, 2016. *See* 37 C.F.R. § 42.122(b).

The statutory provision governing joinder in *inter partes* review proceedings is 35 U.S.C. § 315(c), which reads:

If the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an *inter partes* review under section 314.

A motion for joinder should (1) set forth reasons why joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; (3) explain what impact (if any) joinder would have on the trial schedule for the existing review; and (4) address specifically how briefing and discovery may be simplified. *See Kyocera Corp. v. Softview LLC*, Case IPR2013-00004, slip op. at 4 (PTAB Apr. 24, 2013) (Paper 15).

As noted, the Petition in this case asserts the same unpatentability grounds on which we instituted review in the Cisco IPR. *See* Mot. 5. Dish also relies on the same prior art analysis and expert testimony submitted by the Cisco Petitioners. *See id.* Indeed, the Petition is nearly identical to the

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petition filed by the Cisco Petitioners with respect to the grounds on which review was instituted in the Cisco IPR. *See id.* Thus, this *inter partes* review does not present any ground or matter not already at issue in the Cisco IPR.

If joinder is granted, Dish anticipates participating in the proceeding in a limited capacity absent termination of Cisco Petitioner as a party. *Id.* at 6. Dish agrees to “assume a limited ‘understudy’ role” and “would only take on an active role if Cisco were no longer a party to the IPR.” Dish further represents that it “presents no new grounds for invalidity and its presence in the proceedings will not introduce any additional arguments, briefing or need for discovery.” *Id.* Because Dish expects to participate only in a limited capacity, Dish submits that joinder will not impact the trial schedule for the Cisco IPR. *Id.* at 5–6.

We agree with Petitioner that joinder with the Cisco IPR is appropriate under the circumstances. Accordingly, we *grant* Petitioner’s Motion for Joinder.

V. ORDER

Accordingly, it is:

ORDERED that an *inter partes* review is instituted in IPR2017-00255;

FURTHER ORDERED that the Motion for Joinder with IPR2016-01021 is *granted*, and DISH Network, L.L.C. is joined as a petitioner in IPR2016-01021;

FURTHER ORDERED that IPR2017-00255 is terminated under 37 C.F.R. § 42.72, and all further filings shall be made only in IPR2016-01021;

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